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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,421	08/06/2003	Michael Forman	663P	7325
7590 03/07/2006				
Thomas M. Freiburger P.O. Box 1026 Tiburon, CA 94920				
			EXAMINER LACYK, JOHN P	
			ART UNIT 3735	PAPER NUMBER

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/635,421

Applicant(s)

FORMAN ET AL.

Examiner

John P. Lacyk

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3735

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 11-14, 18, 19, 25, 31-33, 40-43 and 46 is/are rejected.
- 7) ☒ Claim(s) 6-10, 15-17, 20-24, 26-30, 34-39, 44 and 45 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/22/03</u> .  | 6) <input type="checkbox"/> Other: ____                                     |

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 31-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Freire.

Freire discloses a method for treating macular degeneration by sliding a catheter around the globe of an eye to position behind the macular region to treat the area.

Freire also teaches using optical fibers (60) to shine light through the sclera and choroids to locate the device (column 5, lines 14-19).

3. Claim 31 is rejected under 35 U.S.C. 102(e) as being anticipated by Finger.

Finger discloses a method for treating age-related macular degeneration by sliding a catheter around the eye to position behind the macular region to treat the area (column 3, lines 54-61). Finger teaches using lights to provide assistance in locating the device to allow the physician to “look inside the eye and see the area of treatment”, which is considered to inherently allow viewing from the front of the eye and be visible through the sclera, choroids and retina.

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 11-14, 18-19, 25, 40-43, 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freire (5,637,073) in view of Jaafar (2003/0179854).

Freire discloses a method for treating macular degeneration by sliding a catheter around the globe of an eye to position behind the macular region to treat the area.

Freire also teaches using optical fibers (60) to shine light through the sclera and choroids to locate the device (column 5, lines 14-19). While Freire discloses using radiation to treat the area, Freire fails to teach using a switchable x-ray source that is capable of directional emission. Jaafar teaches using a switchable x-ray source (Figures 2a-2d, paragraph 0035) to treat age-related macular degeneration (paragraph 0052). Therefore a modification of Freire to substitute the radiation source for the x-ray source as taught by Jaafar would have been obvious since this would have been the mere substitution of one well known type of radiation source for treating macular degeneration for another and further the x-ray source of Jaafar would provide better and more accurate control of the radiation, both direction and strength, that is exposed to the body such that the radiation source is not exposed to unwanted areas.

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6. Claims 4-5, 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freire in view of Jaafar as applied to claims above, and further in view of Raguin et al (2002/0131699).

While Freire discloses using optical fibers, Freire does not specifically teach the ends being cleaved or polished. Raguin et al teaches (paragraph 0053) that it is well known in the fiber optic art to have the ends cleaved or polished to ensure efficient propagation and to reduce back reflection. Therefore it would have been obvious to modify the optical fibers such that they are cleaved or polished as taught by Raguin et al since this is well known in the fiber optic art to provide a better signal and reduce any unwanted reflections.

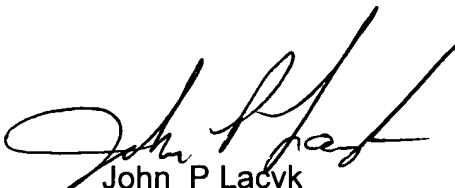
7. Claims 6-10, 15-17, 20-24, 26-30, 34-39 and 44-45 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Lacyk whose telephone number is 571-272-4728. The examiner can normally be reached on Mon-Fri, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ali Imam can be reached on 571-272-4737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P Lacyk  
Primary Examiner  
Art Unit 3735

J.P. Lacyk